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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,825	01/06/2000	Max Abecassis		2218

7590 06/02/2005  
MAX ABECASSIS  
18457 LONG LAKE DRIVE  
BOCA RATON, FL 33496

EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/478,825

Applicant(s)

ABECASSIS, MAX

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004 and 08 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 70-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on Aug. 5, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,208,805 has been reviewed and is accepted. The terminal disclaimer has been recorded.
2. The terminal disclaimer filed on Aug. 5, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,304,715 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 70-96 have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

4. The amendment filed March 8, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

the limitation "said at least one track further storing video segment information, not contained within said video frames, said video segment information comprising video segment addresses identifying the locations of a video segments within the video program, and a segment code indicating whether at least one play control function of

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the apparatus is to be prohibited during a playing of the video segment” of the last six lines of claim 70, the limitation “said at least one track further storing a segment code associated with the video segment address information, and not contained within said video frame, said segment code indicating whether a play control function of the apparatus is to be prohibited during a playing of the video segment” as recited in the last five lines of claim 76, the limitation “said at least one track further storing at least one segment code, associated with the video segment address information, and not contained within said video frames, for prohibiting a play control function of the apparatus during a playing of at least one of the plurality of video segments” of the last five lines of claim 81, the limitation “said at least one track further storing, separately from the plurality of video segments and not within said video frame, video segment information including a video segment address of at least one of the plurality of video segments and at least one code indicating whether one or more of the play control functions of the apparatus is to be prohibited during a playing of the least one of the plurality of video segments” of the last six lines of claim 86, and the limitation “said at least one track further storing video segment information separate from the plurality of video segments and not within said video frames, said video segment information comprising video segment address information identifying a location of a video segment of the video program, and a code indicating whether at least one play function of the apparatus is to be prohibited during a playing of the video segment” of the last six lines of claim 92.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

5. Claims 70-96 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added limitations "said at least one track further storing video segment information, not contained within said video frames, said video segment information comprising video segment addresses identifying the locations of a video segments within the video program, and a segment code indicating whether at least one play control function of the apparatus is to be prohibited during a playing of the video segment" of the last six lines of claim 70, "said at least one track further storing a segment code associated with the video segment address information, and not contained within said video frame, said segment code indicating whether a play control function of the apparatus is to be prohibited during a playing of the video segment" as recited in the last five lines of claim 76, "said at least one track further storing at least one segment code, associated with the video segment address information, and not contained within said video frames, for prohibiting a play control function of the apparatus during a playing of at least one of the plurality of video segments" of the last five lines of claim 81, "said at least one track further storing, separately form the plurality of video segments and not within said video frame, video segment information including a video segment address of at least one of the plurality of video segments and at least

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one code indicating whether one or more of the play control functions of the apparatus is to be prohibited during a playing of the least one of the plurality of video segments” of the last six lines of claim 86, and “said at least one track further storing video segment information separate from the plurality of video segments and not within said video frames, said video segment information comprising video segment address information identifying a location of a video segment of the video program, and a code indicating whether at least one play function of the apparatus is to be prohibited during a playing of the video segment” of the last six lines of claim 92 were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 70-96 are rejected under 35 U.S.C. 101 because claims 70-96 are directed to a laser readable disc storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP §2106.IV.B.1.

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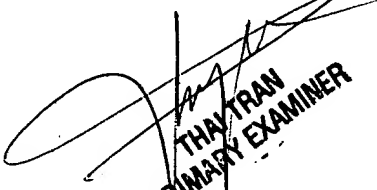
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382.

The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ

  
THAI TRAN  
PRIMARY EXAMINER